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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,919	11/03/2003	Stephen Bowling	115345-00001	3897

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WILLKIE FARR & GALLAGHER LLP
787 Seventh Avenue
New York, NY 10019

EXAMINER

MENDIRATTA, VISHU K

ART UNIT	PAPER NUMBER
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3711

MAIL DATE	DELIVERY MODE
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09/12/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/699,919

Applicant(s)

BOWLING, STEPHEN

Examiner

Vishu K. Mendiratta

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-34, 41, 43 and 44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 31 is/are allowed.
- 6) ☒ Claim(s) 21-27, 29, 30, 32-34, 41, 43, 44 is/are rejected.
- 7) ☒ Claim(s) 28 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Specification

1. The amendment filed 10/21/05 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Spheres of different sizes in claim 25.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 102

2. Claims 21-23,25,26,43 rejected under 35 U.S.C. 102(b) as being anticipated by Falk (5692753).

Claims 21,22,23,25,26,43: Falk teaches a game kit having a game board (1), a plurality of marbles (5)/spheres (2:27-31) as marbles. It is well known in the marble world to have marbles in design depending on the visible inside figures that vary from colored flowers, animals, geometric figures and numerous characters. Transparent glass marbles with visible figures inside is a common sight with children playing all kinds of games including "striking" games. It will be difficult to disassociate "visible figures within", "colors", "different colors and figures combined in design" and "striking" terms from marbles. There is sufficient inherency for these terms with marbles and game playing using marbles. Falk further teaches a random number generator (9). Falk also teaches information indicator indicia (in this case a game board with directional lines) and rules for indicating marble moving according to roll of dice.

Claim 25: Falk teaches distinguishing marbles by size (2:27-31). Applicant admits that marbles inherently are known in varying sizes “because of shapes” (amendment page 6).

Claim 26: It is inherent in designing marbles to have figures and colors visible. Such marbles inherently several different figures, colors within one marble to be treated as “at least two indicators”. Marble designs can be readily found on internet.

3. Claims 27,29,30,32-34,41 rejected under 35 U.S.C. 102(b) as being anticipated by Hanna (4846476).

Claims 27,29,30,32-34,41: Hanna teaches a method of playing a game providing a plurality of striking spheres, each individually having visual figure/ numbers (2:3-8) indicia associated **with it**, a random number generator (24), placing a first and all other balls in the chamber (12), striking the first ball with a second ball (Fig.1, balls striking in line in playing fields 19 and 25) and arranging balls in a line for lottery outcome.

Applicant may note that a common practice in the lottery area is allowing balls to float in a chamber, a random generator selecting a number of numbered balls in sequence and stacking in a tube one behind the other to create a lottery outcome.

Claim limitations 32-34 are inherent in the above described method of playing lottery wherein balls are removed and repositioned for the next round. Claims have broad terminology and the examiner is required to interpret the broadest meaning.

Claim 41: In a lottery game a lottery ticket inherently available can be used as a card.

Claim Rejections - 35 USC § 103

4. Claims 24,44 rejected under 35 U.S.C. 103(a) as being unpatentable over Falk in view of Fogarty (4884818).

Claim 24: Falk teaches all limitations except that it does not teach a sphere with a flat base.

Fogarty teaches game pieces in spherical shapes with a flat base (Fig.2)

Spherical shapes are attractive to players but the game pieces are not stable and likely to roll off of the game area disturbing the game playing. In order to play without interruption, it would have been obvious to give a flat base to the spherical game pieces. One of ordinary skill in art at the time the invention was made would have suggested modifying spherical game piece to have a flat base.

Claim 44: Falk teaches all limitations except that it does not teach providing a card. Fogarty provides cards with the kit (Fig.3).

The art area of game boards recognizes random selection devices in alternate forms such as skimmers, cards, dice or computer forms. In order to make the game attractive, it would have been obvious to provide alternative devices for potential players who like to use one kind as opposed to another kind of random device.

One of ordinary skill in art at the time the invention was made would have suggested providing cards along with other articles in kit.

Allowable Subject Matter

5. Claim 28 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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6. Claim 31 allowed.
7. Applicant's arguments with respect to claims 21-27,29-30,32-34,41,43,44 have been considered but are moot in view of the new ground(s) of rejection.
8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vishu K. Mendiratta whose telephone number is (571) 272-4426. The examiner can normally be reached on Mon-Fri 8AM to 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on (571) 272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Vishu K Mendiratta
Primary Examiner
Art Unit 3711

VKM
August 23, 2007